REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed June 03, 2004. Claims 1, 3, 22, 27, 30, 34, and 41 have been amended herein. Claim 5 has been canceled and claims 44-47 have been added herein. Support for amendments and newly added claims can be found, for example, in the specification on page 9, line 17 through page 10, line 8. Upon entry of this response, claims 1, 3-4, 22-32, 34, and 41-47 remain pending in the present application.

In the Office Action, pending claims 1, 3-5, 22-32, 34, and 41-43 have been preliminarily rejected for obviousness under 35 U.S.C. § 103. The Applicant traverses all of the objections and rejections of the Office Action. Reconsideration and allowance of the subject application and presently pending claims 1, 3-4, 22-32, 34, and 41-47 is respectfully requested.

I. Response to Claim Objection

In the Office Action, claim 34 was objected to by the Examiner. The Examiner was correct; claim 34 should depend from claim 30. The Applicant has amended claim 34 herein to depend on claim 30. The Applicant thanks the Examiner for bringing the typographic error to the Applicant's attention.

II. Response To Claim Rejections Based On Obviousness

In the Office Action, claims 1, 3-5, 27-32, 34, and 41-43 have been preliminary rejected as obvious under 35 U.S.C. § 103. Specifically, claims 1 and 3-5 have been rejected

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under 35 U.S.C. § 103 by U.S. Patent No. 5,724,667 to Furuno (hereafter, "Furuno") in view of U.S. Patent No. 6,059,081 to Patterson *et al.* (hereafter, "Patterson"), claims 22-26 have been rejected under 35 U.S.C. § 103 by U.S. Patent No. 5,724,667 to Furuno in view of U.S. Patent No. 6,059,081 to Patterson *et al.* (hereafter, "Patterson") and U.S. Patent No. 6,587,674 to Isberg *et al.* (hereafter, "Isberg"), and claims 27-34 and 41-43 have been rejected under 35 U.S.C. § 103 by U.S. Patent No. 6,082,656 to Thornton (hereafter, "Thornton") in view of U.S. Patent No. 6,633,770 to Gitzinger *et al.* (hereafter, "Gitzinger").

It is well settled law, that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

> The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ... ***Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure...*** In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention.
>
> (***Emphasis added***) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

A. Claim 1

Amended independent claim 1 reads:

> A cable retractor assembly, comprising:
> an enclosure for housing a rotatable reel, the enclosure having a first side and an opposing second side;
> a biasing member coupled to the reel and the enclosure for urging the reel to rotate in a predetermined direction;

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> a first plurality of terminals disposed on the first side of the enclosure; and
>
> a second plurality of terminals disposed on the second side of the enclosure, the first plurality of terminals electrically coupled to the second plurality of terminals, ***wherein the first plurality of terminals is coupleable to a power supply external to a portable communications device and the second plurality of terminals is coupleable to the portable communications device.***

(Emphasis Added)

The Applicant respectfully submits that Furuno in view of Patterson fails to disclose, teach, or suggest all elements of the rejected claim for at least the reasons that follow. Furuno discloses a first plurality of terminals coupled to a battery 23. However, Furuno does not disclose, teach, or suggest the first plurality of terminals coupled to a power supply external to the portable communication device.

In this regard, the Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create a first plurality of terminals coupleable to a power supply external to an electronic device as claimed by the Applicant.

The earphone 27 of Furuno is coupled to a take-up mechanism. The take-up mechanism allows the user to remove the earphone and adjust the cable connected to the earphone to the desired distance based on the height of the user and the storage location on the user body as the

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user uses the portable phone. An individual skilled in the art at the time of the invention would not be motivated to combine the teachings of Patterson with the teaching of Furuno. The portable telephone of Furuno has a battery 23. When the phone is in use, the battery typically powers the phone. The user only uses the power cord to charge the battery. The user would have little value for a retractable power cord. The additional weight of the power cord and retraction mechanism added to the portable phone would not motivate an individual skilled in the art to combine the power cord and retraction mechanism of Patterson with the portable telephone of Furuno.

Even if an individual skilled in the art at the time of the invention were motivated to combine Patterson's power accessories with the portable phone, which the Applicant does not concede, the result would not be the invention claimed in the Applicant's claim 1. The Applicant's claim 1 discloses an enclosure for housing a rotatable reel with the first plurality of terminals coupleable to a power supply external to an electronic device. If one were to combine the teachings of Furuno and Patterson, the result would be a retraction assembly in a separate housing from the housing of the portable phone. This is not what is claimed in the Applicant's claim 1.

Therefore, based on the lack of motivation and the combined teachings not disclosing the invention recited in claim 1, the Applicant respectfully requests that the Examiner withdraw the rejection.

B. Claims 3-4

The Applicant respectfully submits that since claims 3-4 depend on independent claim 1, claims 3-4 contain all limitations of independent claim 1. Since

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independent claim 1 should be allowed, as argued above, pending dependent claims 3-4 should be allowed as a matter of law for at least this reason. In re Fine, 5 U.S.P.Q. 2d 1596, 1608 (Fed. Cir. 1988).

C. Claim 22

Amended independent claim 22 reads:

> A cable retractor assembly coupleable to a communications device, comprising:
> an enclosure for housing a rotatable reel, wherein the enclosure is detachably coupleable to the communications device;
> a biasing member coupled to the reel and the enclosure for urging the reel to rotate in a predetermined direction;
> an actuator coupled to the enclosure to signal the communications device to pick up an incoming call; and
> ***a vibrator designed to vibrate when the actuator picks up the incoming call and the biasing member is rotated in a direction opposite the predetermined direction.***

(Emphasis Added)

The Applicant respectfully submits that Furuno in view of Patterson and Isberg fails to disclose, teach, or suggest at least the above-emphasized element of currently amended claim 22. Claim 22 specifically recites, "a vibrator designed to vibrate when the actuator picks up the incoming call and the biasing member is rotated in a direction opposite the predetermined direction." Furuno does not disclose, teach, or suggest a cable retractor with a vibrator for coupling to a communication device. Neither Patterson nor Isberg cure this deficiency. The Applicant claims a vibrator that vibrates when the actuator picks up the incoming call and the biasing member is rotated in a direction opposite to the predetermined

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direction, which is not disclosed, taught, or suggested by either Furuno, Patterson, or Isberg, either individually or in combination.

As a result of at least the above mentioned, the Applicant respectfully submits that claim 22 is allowable and allowance is respectfully requested.

D. Claims 23-26

The Applicant respectfully submits that since claims 23-26 depend on independent claim 22, claims 23-26 contain all limitations of independent claim 22. Since independent claim 22 should be allowed, as argued above, pending dependent claims 23-26 should be allowed as a matter of law for at least this reason. In re Fine, 5 U.S.P.Q. 2d 1596, 1608 (Fed. Cir. 1988).

E. Claim 27

Amended independent claim 27 reads:

> A cable retractor assembly coupleable to a portable communications device, comprising:
>
> a communications circuit for sending and receiving wireless communications signals;
>
> a cable retractor assembly for retracting a coupled cable, the cable comprising a first end and a second end, the first end coupled to the communications circuit and the second end comprising a speaker;
>
> an enclosure for housing the communications circuit and the retractor, wherein the enclosure is detachably coupleable to the communications device;
>
> a sensor to determine if the speaker is extended or retracted from the communication device; and
>
> ***a micro controller programmed to send an audio signal to the speaker when the communications circuit***

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receives a wireless communications signal and the sensor determines the speaker is extended from the communication device.

(Emphasis Added)

The Applicant respectfully submits that Thornton in view of Gitzinger fails to disclose, teach, or suggest at least the above-emphasized element of currently amended claim 27. Claim 27 specifically recites, "a micro controller programmed to send an audio signal to the speaker when the communications circuit receives a wireless communications signal and the sensor determines the speaker is extended from the communication device." Thornton does not disclose, teach, or suggest a cable retractor with a micro controller that transmits an audio signal based on the speaker position. Gitzinger does not cure this deficiency. The Applicant claims a micro controller to send an audio signal to the speaker based on the sensor determining that the speaker is in an extended position, which is not disclosed, taught, or suggested by either Thornton or Gitzinger, either individually or in combination.

As a result of at least the above mentioned, the Applicant respectfully submits that claim 27 is allowable and allowance is respectfully requested.

F. Claims 28-29

The Applicant respectfully submits that since claims 28-29 depend on independent claim 22, claims 28-29 contain all limitations of independent claim 22. Since independent claim 22 should be allowed, as argued above, pending dependent claims 28-29 should be allowed as a matter of law for at least this reason. In re Fine, 5 U.S.P.Q. 2d 1596, 1608 (Fed. Cir. 1988).

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G. Claim 30

Amended independent claim 30 reads:

> A cable retraction assembly, comprising:
> a reel rotatable about an axis for the winding and unwinding of a cable, the cable having at least two electrical conductors;
> a biasing member coupled to the reel for urging the reel to rotate in a first direction;
> a force applicator for resisting winding and unwinding of the cable; and
> an enclosure for housing the reel, the biasing member, and the force applicator wherein the enclosure is detachably coupleable to ***an electronic device having an alert device wherein the cable retraction assembly deactivates the alert device when the cable is unwound from the reel.***

(Emphasis Added)

The Applicant respectfully submits that Thornton in view of Gitzinger fails to disclose, teach, or suggest at least the above-emphasized element of currently amended claim 30. Claim 30 specifically recites, "an electronic device with an alert device wherein the cable retraction device deactivates the alert device when the cable is unwound from the reel." Thornton does not disclose, teach, or suggest a cable retraction assembly deactivating an alert device of the electronic device. Gitzinger does not cure this deficiency. The Applicant claims a cable retraction assembly deactivating an alert device of the electronic device, which is not disclosed, taught, or suggested by either Thornton or Gitzinger, either individually or in combination.

As a result of at least the above mentioned, the Applicant respectfully submits that claim 30 is allowable and allowance is respectfully requested.

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H. Claims 31-32 and 34

The Applicant respectfully submits that since claims 31-32 and 34 depend on independent claim 30, claims 31-32 and 34 contain all limitations of independent claim 30. Since independent claim 30 should be allowed, as argued above, pending dependent claims 31-32 and 34 should be allowed as a matter of law for at least this reason. In re Fine, 5 U.S.P.Q. 2d 1596, 1608 (Fed. Cir. 1988).

I. Claim 41

Amended independent claim 41 reads:

> A cable retractor, comprising;
> an enclosure detachably coupleable to a portable electronic device;
> a rotatable reel;
> a biasing member secured to the enclosure and the reel to urge the reel to rotate in a predetermined direction;
> a length of cable having a first end and a second end, the first end coupled to the reel and the second end having a speaker coupled thereto;
> a plurality of terminals secured to the enclosure, the terminals electrically coupled to the first end of the cable and electrically coupleable to the portable electronic device;
> a communications circuit for sending and receiving wireless communications signals;
> a sensor to determine if the biasing member is rotated in a direction opposite the predetermined direction; and
> ***a micro controller programmed to send an audio signal to the speaker when the communications circuit receives a wireless communications signal and the sensor determines the biasing member is rotated in the direction opposite the predetermined direction.***

(Emphasis Added)

The Applicant respectfully submits that Thornton in view of Gitzinger fails to disclose, teach, or suggest at least the above-emphasized element of currently

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amended claim 41. Claim 41 specifically recites, "a micro controller programmed to send an audio signal to the speaker when the communications circuit receives a wireless communications signal and the sensor determines the biasing member is rotated in the direction opposite the predetermined direction." Thornton does not disclose, teach, or suggest a cable retractor with a micro controller that transmits an audio signal based on the rotation of the biasing member. Gitzinger does not cure this deficiency. The Applicant claims a micro controller to send an audio signal to the speaker based on the sensor determining the rotation of the biasing member, which is not disclosed, taught, or suggested by either Thornton or Gitzinger, either individually or in combination.

As a result of at least the above mentioned, the Applicant respectfully submits that claim 41 is allowable and allowance is respectfully requested.

J. Claims 42-43

The Applicant respectfully submits that since claims 42-43 depend on independent claim 41, claims 42-43 contain all limitations of independent claim 41. Since independent claim 41 should be allowed, as argued above, pending dependent claims 42-43 should be allowed as a matter of law for at least this reason. In re Fine, 5 U.S.P.Q. 2d 1596, 1608 (Fed. Cir. 1988).

III. Newly Added Claims

Claims 44-47 have been added to better define the Applicant's invention. The Applicant believes newly added claims 44-47 are patentable over the cited references.

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A. Claim 44

Newly added independent claim 44 reads:

> A portable communications device, comprising:
> a cable with a proximal end and a distal end;
> an earpiece coupled to the distal end of the cable;
> a cable retractor for retracting the cable and coupled to the proximal end of the cable;
> a sensor to determine if the earpiece is extended or retracted from the portable communication device;
> a ringer coupled to the portable communication device;
> a circuit for determining the presence of an incoming call; and
> ***a micro controller programmed to deactivate the ringer when the circuit determines the presence of the incoming call and the sensor determines the earpiece is extended from the portable communication device.***

(Emphasis Added)

The Applicant respectfully submits that none of the prior art references cited by the Examiner disclose, teach, or suggest at least the above-emphasized element of newly added claim 44. Claim 44 specifically recites, "a micro controller programmed to deactivate the ringer when the circuit determines the presence of the incoming call and the sensor determines the earpiece is extended from the portable communication device." Thornton does not disclose, teach, or suggest a cable retractor with a micro controller that transmits an audio signal based on the rotation of the biasing member. Gitzinger does not cure this deficiency. The Applicant claims a micro controller to deactivate the ringer based on the receipt of an incoming call and the position of the

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earpiece, which is not disclosed, taught, or suggested by either Thornton, Gitzinger, or any other references cited by the Examiner, either individually or in combination.

As a result of at least the above mentioned, the Applicant respectfully submits that claim 44 is allowable and allowance is respectfully requested.

B. Claims 45-47

The Applicant respectfully submits that since claims 45-47 depend on independent claim 44, claims 45-47 contain all limitations of independent claim 44. Since independent claim 44 should be allowed, as argued above, pending dependent claims 45-47 should be allowed as a matter of law for at least this reason. In re Fine, 5 U.S.P.Q. 2d 1596, 1608 (Fed. Cir. 1988).

1. Claim 45

In addition to the above mentioned, none of the references cited by the Examiner disclose, teach or suggest the micro controller activating a vibrator when an incoming call is received and the earpiece is extended. Therefore, the Applicant respectfully submits that claim 45 should be allowed.

2. Claim 46

In addition to the above mentioned, none of the references cited by the Examiner disclose, teach or suggest the micro controller activating the ringer to send an audio signal to the earpiece when an incoming call is received and the earpiece is

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extended. .Therefore, the Applicant respectfully submits that claim 46 should be allowed.

3. Claim 47

In addition to the above mentioned, none of the references cited by the Examiner disclose, teach or suggest the micro controller activating the ringer when an incoming call is received and the earpiece is retracted. Therefore, the Applicant respectfully submits that claim 47 should be allowed.

IV. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, the Applicant respectfully submits that all objections and rejections have been traversed, rendered moot and/or accommodated, and that presently pending claims 1, 3-4, 22-32, 34, and 41-47 are in condition for allowance. Favorable reconsideration and allowance of the present application and the presently pending claims are hereby courteously requested. If in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (603) 668-1400.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313-1450 on September 1, 2004 at Manchester, New Hampshire.

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